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Docket No.: 202127US2

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COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 09/764,431

Applicants: Yoshikazu WATANABE

Filing Date: January 19, 2001

For: DIGITAL CAMERA, METHOD OF SHOOTING AND  
TRANSFERRING TEXT

Group Art Unit: 2615

Examiner: LONG, HEATHER R.

SIR:

Attached hereto for filing are the following papers:

**Provisional Election**

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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DOCKET NO: 202127US

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
YOSHIKAZU WATANABE : EXAMINER: LONG, HEATHER R.  
SERIAL NO: 09/764,431 :  
FILED: JANUARY 19, 2001 : GROUP ART UNIT: 2615  
FOR: DIGITAL CAMERA, A METHOD :  
OF SHOOTING AND TRANSFERRING :  
TEXT

PROVISIONAL ELECTION

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Restriction Requirement dated November 5, 2004, Applicant elects with traverse Group II, Claims 12-43. Applicant makes this election based on the understanding that Applicant is not prejudiced against filing one or more divisional applications that cover the non-elected claims.

In addition to making this election, Applicant respectfully traverses this Restriction Requirement as the inventions of Groups I and II have not been shown to be distinct in the manner required by M.P.E.P. §806.05(c), and the inventions of Groups I and III have not been shown to be distinct in the manner required by M.P.E.P. §806.05(d).

Concerning Groups I and II, M.P.E.P §806.05(c) requires that the Patent Office demonstrate either (1) that a combination as claimed does not require the particulars of the subcombination as claimed for patentability and (2) that the subcombination can be shown to have utility either by itself or in other and different relations. The Restriction Requirement

on page 2 states that “the combination as claimed does not require the particulars of the subcombination as claimed because generic image processing does not require specific image quality enhancement.”

However, this assertion by the Patent Office that the claimed combinations do not require the particulars of the subcombination for patentability is without basis as no showing or discussion of the applied prior art necessary for a determination of patentability has been made. Thus, it is respectfully submitted that the outstanding restriction cannot be said to have met the requirement of MPEP §806.05(c). Accordingly, the restriction is traversed.

Concerning Groups I and III, M.P.E.P §806.05(d) requires that the Patent Office show that two or more subcombinations disclosed as usable together in a single combination are separately usable, in order for the claimed subcombinations to be distinct. Furthermore, M.P.E.P §806.05(d) requires that the examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. Pages 2 and 3 of the Restriction Requirement merely states that “...invention III has separate utility such as correcting image data for camera orientation prior to storage in the camera, without performing other generic processing.”

The Restriction Requirement fails to identify the “disclosed combination” or the “subcombinations” and therefore fails to show that two or more subcombinations disclosed as usable together in a single combination are separately usable. As such, there is no basis upon which Applicant can determine if the asserted subcombinations are indeed subcombinations usable together in a single combination, or if one of the asserted subcombinations has utility other than in a disclosed combination, as required in M.P.E.P §806.05(d). Accordingly the restriction is traversed.

Furthermore, MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on

the merits, even though it includes claims to distinct or independent inventions.

Applicant also respectfully traverses the Restriction Requirement on the grounds that it has not ever been indicated that a search and examination of the entire application would place a *serious* burden on the Examiner, whereas it would clearly be burdensome on Applicant to be required to file, prosecute, and maintain separate applications and patents on the identified.

Accordingly, it is respectfully requested that the requirement to elect a single group be withdrawn, and that a full examination on the merits of Claims 1-16 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



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